

REMARKS

Amendment to the Specification

The paragraph on page 2, lines 22-26 has been amended to eliminate direct references to the claims.

A Brief Description of the Drawings section has been added to the specification. With regard to the other headers, the MPEP only suggests but does not require the headers to be present. A school of thought led by Professor (emeritus) Irving Kayton of George Mason University propounds that headers should not be included in order to avoid problems during any future litigation of the patent. Therefore, the applicants respectfully decline to enter these headers as requested.

Amendment to the Claims

Claims 1 and 2 have been amended to further distinguish the claimed subject matter from the prior art. Support for the phrase "via a kiss cut process" can be found e.g. on page 1, line 14 of the specification. Support for the "changes in electrical conductivity" can be found e.g. on page 2, line 20 of the specification. The applicants reserve the right to pursue the originally filed subject matter in a divisional application.

Claims 1-17 are still pending. It is believed that no new matter has been added.

35 U.S.C. 102(b) rejection

Claims 1-3, 8, 10, 11 and 13 were rejected as being anticipated by Gruese et al. (U.S. Patent 5,250,336 - hereafter referred to as "Gruese"). The applicants request reconsideration of the rejection based on the claims as amended.

MPEP 2131 states that to anticipate a claim, the reference must teach every element of the claim, i.e. "The identical invention must be shown in as complete detail as is contained in the...claim." see *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d, 1913, 1920 (Fed. Cir. 1989).

The amendments to the claims now specify a specific type of die cutting procedure, i.e. kiss-cutting and also state that coloring of the backing is done in such a way as to prevent avoid abrasion on the punching

tool or changes in the electrical conductivity of the backing sheet. These elements of the invention are not shown in the Gruese reference in as complete detail as in the applicants' claims.

With regard to kiss-cutting, there is no indication that Gruese envisions the use of kiss-cutting with their procedure or that there was any recognition that using kiss-cutting procedures would result in the properties associated with the protective material described by the applicants. In fact, the nature of Gruese's invention appears not to reside in improving the laminate compositions of their invention but merely providing an easier means of detecting defective laminate compositions produced by die cutting (see e.g. col. 7, lines 56-62 - "The instant invention contemplates...coloration...so that imperfections in die cutting, and/or printing respectively will be readily visually apparent.")

With regard to the abrasion and electrical conductivity limitations of the applicants' claims, there is no recognition by Gruese to select appropriate colorants which avoid these properties. In fact, if relying upon the specific guidance actually provided by Gruese, one of ordinary skill in the art would be directed toward the use of carbon black (see e.g. col. 7, lines 64 - col. 8, line 23 and claim 1) which is specifically excluded by the applicants electrical conductivity limitation (see applicants specification, page 2, lines 13-15). Moreover, Gruese indicates that "[t]he coloration of a label release liner is an inherently difficult problem." (see col. 6, lines 65-66) and that their selections for coloration is such that "[t]he colorant of this invention does not affect the release characteristics which exist at the release coating/releasable adhesive interface." (see col. 7, lines 29-31) and "[t]he colorant does not migrate into either the backing paper or the releasable adhesive." (see col. 7, lines 42-43).

For the reasons given above, it is believed that the Gruese reference does not anticipate the applicants' claims as amended.

35 U.S.C. 103(a) rejection

Claims 4-7, 9, 12 and 14-17 were rejected as being obvious over Gruese, *Id.*, in view of Higgins (U.S. Patent 5,932,352). The applicants request reconsideration of this rejection based on the claims as amended.

The applicants analysis of the Gruese reference are to be considered repeated here. In addition, with regard to any potential argument that the selection of alternative colorants based on the teachings of Gruese would be obvious, while it is not necessary that the motivation for modifying the reference be the same as intended use of the applicants invention, there must be a (1) teaching, suggestion or motivation

and (2) a reasonable expectation for success in making the modification to the primary reference necessary to arrive at the applicants' invention.

For the present reference, there does not appear to be any teaching, suggestion or motivation to use alternative colorants and even if so argued, there is no indication that selection of a colorant which had Gruese's desired properties, i.e. not affecting the release characteristics which exist at the release coating/releasable adhesive interface or not having the colorant migrate into either the backing paper or the releasable adhesive, would result in the properties claimed by the applicants, i.e. avoid abrasion on the punching tool or changes in the electrical conductivity of the backing sheet, especially in light of Gruese's own statement that selection of colorants is a "difficult problem".

As the Higgins reference was used to address other limitations represented by the dependent claims, this reference does not remedy the deficiencies of the Gruese reference for the claims as amended and as such it is believed that the amended claims are unobvious over Gruese in view of Higgins. However, for completeness' sake the combination of Gruese and Higgins is addressed below.

Although the Higgins references teaches certain pieces of the applicants claimed invention, it is not sufficient to simply find individual elements and combine them together. As stated in *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998):

"As this court has stated, 'virtually all [inventions] are combinations of old elements...Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.' *Sensotronics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996)."

Rouffet, 149 F.3d at 1357, 47 USPQ2d 1457. In describing the motivation to combine the references, the Examiner stated that Gruese is also concerned with "minimizing silicone debris". However, there does not appear to be an evidentiary support for this statement. Absent this fact, the motivation for combining the references is reduced to a "could be combined" standard which is improper for establishing *prima facie* obviousness. See MPEP 2143.01.

With regard to claims 9, 16 and 17, the Examiner is reminded that MPEP 2143.03 states that "To

establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).". These claims did not appear to be addressed in the previous office action.

For the reasons given above, it is believed that the applicants claims as amended are unobvious over the combination of Gruese and Higgins.

Closing

Applicants also believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 (9 pages) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: 7 April 2004

By: Agata Glinska
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